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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,271	09/13/2000	Perry S. Ward	10304-003-999	8302

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EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,271

Applicant(s)

WARD ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Declarations filed March 10, 2004, November 10, 2004 under 37 CFR 1.131 and the Declaration filed October 11, 2005 under 37 CFR 1.132 (as supplement to those filed under 37 CFR 1.131) have been considered, but are ineffective to overcome the Schmid (US 2002/0029188 A1) reference.

Declaration of Heil, Scavone, and Ward

filed November 10, 2004

Although the Declaration alleges that conception of the invention was made in the United States, the Declaration does not contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104.

Under 37 CFR 1.131(a), which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act,

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and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act. Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country. MPEP 715.07(c).

The evidence submitted is sufficient to establish diligence from a date prior to the date of reduction to practice of the Schmid reference to either a constructive reduction to practice or an actual reduction to practice. See discussion of Morris Declarations below.

Applicant makes no allegation of an actual reduction of practice. Accordingly, the Office will consider Applicant's constructive reduction to practice of July 21, 2000. Further, since there is no actual reduction to practice prior to the effective date of the reference, diligence must be shown.

The critical period in which diligence must be shown begins just prior to the effective date of the reference and ends with the date of the reduction to practice. In the instant case this

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critical period begins just prior to December 20, 1999 and ends July 21, 2000.

Declarations of Morris

filed November 10, 2004 and October 11, 2005

The Declarations of Francis E. Morris filed November 10, 2004 and October 11, 2005, when taken together with the evidence provided therein, respectively, is effective for the purposes of establishing diligence between just prior to December 20, 1999 and July 21, 2000. Such Declarations show that Applicant diligently moved to reduce the invention to a constructive reduction to practice by engaging services related to the filing of a United States patent application. The evidence supplied shows exact dates over a range of dates extending over the period of time identified as the critical period in which diligence must be shown and associated and specific tasks which were to be performed in order to achieve the subsequent filing of the instant application.

The Declaration of Morris filed October 11, 2005 is not effective for the purposes of providing an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country

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or WTO member country (an allegation to this effect is made by Mr. Morris at item 3 of the Declaration filed October 11, 2005). This is because such allegation is not made by one of the entities identified in 37 CFR 1.131 as being authorized to make such allegation. 37 CFR 1.131 identifies such entities are identified as:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
- (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of

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the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G.
261 (Comm'r Pat. 1903).

Mr. Morris does not appear to be qualified under any of
items "A"-"D" to satisfy the requirements of 37 CFR 1.131.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs
of 35 U.S.C. 102 that form the basis for the rejections under
this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-9, 11-81, and 83-109 are rejected under 35
U.S.C. 102(e) as being anticipated by Schmid (US 2002/0029188
A1).

Schmid discloses a method (see Figs. beginning at 3A),
computer system (see Fig. 2), and software program (par. [0051])
for facilitating a loan origination (par. [0007]). Schmid
discloses underwriting information development (par. [0026]),

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access by the prospective lenders to such information; opportunity for the lenders to submit at least one bid (pars. [0033] and [0040]); and providing opportunity for consideration of such bid (par. [0046]).

Schmid discloses a plurality of underwriting levels. Specifically, Schmid discloses the availability of Summary Project Data Files (SPDF) (par. [0031]), Complete Project Data Files (CPDF) (par. [0036]), and third-party due diligence reports (par. [0028]).

Schmid teaches that the method has strictly scheduled timelines and deadlines (beginning at par. [0038]).

Regarding system claims 39-73, the manner in which the system is intended to function, absent any recitation of structure, does not provide the patentable moment necessary in distinguishing the instant system from the system already disclosed by Schmid. MPEP 2114.

Regarding claim 109, underwriting is a process of evaluating a loan application to determine the risk involved for the lender. It may involves an analysis of the borrower's creditworthiness and the property itself. To that end, Schmid discloses that the lending sources undergo an underwriting of the potential loan. The lending sources disclosed by Schmid perform due diligence in the evaluation of underwriting

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information. The lending sources in doing so are engaging in risk assessment. The lending sources may request additional historical records etc (par. [0036]) in an effort to evaluate the risk to the lender associated with the potential loan.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 2002/0029188 A1).

Schmid does not specifically disclose representations and warranties that specific procedures were followed in developing the underwriting information. However, it is noted that the Schmid method offers third-party due diligence documentation (par. [0028]). Since such documentation is provided by a third-party and since the lender weighs such documentation in its risk

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assessment, it is clear that the credibility of the third-party provider would have been of extreme interest to the lender.

It would have been obvious to one of ordinary skill in the art to have provided the method of Schmid to have included an explicit representation and warranty that specific procedures are followed in developing underwriting information (such as that provided by the third-party provider of Schmid) in order to have reduced risk by ensuring the credibility of all parties with whom the lender conducts business.

Claims 10 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 2002/0029188 A1).

Schmid does not disclose a designation of at least one lender whom the applicant does not want to be informed of applicant's request for a loan. However, Schmid does disclose functionality which permits a lender to indicate a willingness to see projects of a desired type. Such functionality serves as an "internal screening" of the lending source database to create a list of prospective lending sources who may have initial interest in reviewing applicant's request for a loan (see par. [0023]).

It would have been obvious to one of ordinary skill in the art to have provided the method, system, and software of Schmid

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to have included similar functionality for the screening of prospective lenders by applicant in order to have allowed the applicant to have similarly performed an "internal screening" of the Schmid lending source database to create a list of prospective lending sources which the applicant has a willingness to transact business with.

Claims 110 and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 2002/0029188 A1) in view of Official Notice.

Regarding claim 110: Although Schmid does not disclose a sealed bid format, Official Notice is taken that sealed bid formats are often employed in order that competing bidders may not gather information from others' bids in order to generate their own bid. The benefit of this format is that each bidder must evaluate for themselves the value of the item bid on. It would have been obvious to one of ordinary skill in the art to have provided the auction method of Schmid to have included a sealed bid format in order to have generated bids which reflect a bidders assessment of the value of a particular loan without outside influence from other bidders participating in the auction.

Regarding claim 111, it is noted that the step of providing the prospective lenders an opportunity in an auction to submit at least one open bid is a conditional step which may never be actually performed. It is only performed upon the condition that a sealed bid is not accepted. Accordingly, the recitations of this claim are considered met in the manner discussed above with regard to claim 110.

Response to Arguments

Applicant's arguments filed October 11, 2005 have been fully considered.

Applicant's remark that "[o]n information and belief all the foregoing activity was performed in the United States" is not persuasive. Such remark cannot take the place of the specific requirement in 37 CFR 1.131 which requires an entity identified in 37 CFR 1.131 make such allegation pursuant in affidavit or declaration form.

Since the collective Declaration under 37 CFR 1.131 is not effective in removing the rejection in view of Schmid, they have, accordingly remained in place.

The rejections under 35 USC 101 have been vacated either in view of persuasive argument, as in the case of claim 74-108, in view of the current amendment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

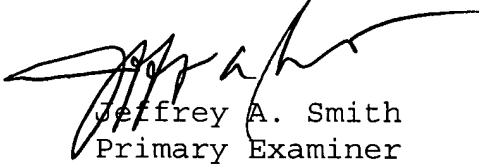
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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